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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

S01.12-0851

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on September 8, 2005

Signature _____

Typed or printed name Brian D. Kaul

Application Number

10/027,046

Filed

12/20/01

First Named Inventor

Alexander M. Shukh

Art Unit

2652

Examiner

David Donald
Davis

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 41,885

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Brian D. Kaul

Typed or printed name

(612) 334-3222

Telephone number

September 8, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

Applicant is requesting a Pre-Appeal Brief review of the withdrawal of claim 23 from prosecution and the rejections of claims 1-18, 20-22, 24 and 25 in the Office Action mailed June 9, 2005 relating to the above-identified application.

Improper Withdrawal of Claim 23

Applicant requests review of the Examiner's withdrawal of claim 23 from prosecution as being drawn to a non-elected species. As discussed on pages 8 and 9 of Applicant's response to the Office Action mailed August 9, 2005, Applicant identified claim 23 in the response filed February 11, 2005, as reading on the elected species. The Examiner has failed to provide Applicant any explanation as to why claim 23 does not read on the elected species. Therefore, Applicant submits that the withdrawal of claim 23 from prosecution is improper and requests that claim 23 be admitted for prosecution. Applicant also submits that claim 23, which has not been rejected, is in condition for allowance.

Claim Rejections - 35 U.S.C. §102

Applicant requests review of the Examiner's rejection of claims 1-3, 7-16, 20-22, 24 and 25 under 35 U.S.C. §102(e) as being anticipated by Lin (2003/0043513).

As discussed on pages 10 and 11 of Applicant's response to the Office Action mailed August 9, 2005, Lin fails to disclose the claimed "first direction" that the moving magnetic medium (17) is traveling, from which the relative positions of the cited main (22) and return poles (23) can be determined. Accordingly, there is no basis from which to assert that the positions of the

cited return and main poles of Lin relative to the moving magnetic medium are any different than that of the prior art, such as that described in the present application with reference to FIGS. 2 and 3.

Accordingly, Lin fails to teach or suggest "a head for use with a magnetic medium moving in a first direction . . . comprising . . . a perpendicular writing element including a main pole having a main pole tip, a return pole connected to the main pole at a back gap and having a return pole tip positioned from the main pole in the first direction", as described in claim 1; "a head for use with a magnetic medium moving in a first direction, the head comprising a perpendicular writing element including a main pole having a main pole tip, a return pole connected to the main pole at a back gap and having a return pole tip position from the main pole in the first direction", as described in claim 10; "a head for recording perpendicularly oriented magnetic patterns to a magnetic medium moving in a first direction, the head comprising main and return poles separated by a write gap, the return pole positioned from the main pole in the first direction", as described in claim 14; or "a head for use with a magnetic medium moving in a first direction . . . comprising . . . a return pole having a return pole tip located in the first direction from the main pole", as described in claim 20.

Therefore, Applicant submits that independent claims 1, 10, 14 and 20 are not anticipated by Lin, and requests that the rejections be withdrawn. Additionally, Applicant submits that all claims depending from independent claims 1, 10, 14 and 20 are allowable as being dependent from allowable base claims, and requests that the rejections be withdrawn.

Claim Rejections - 35 U.S.C. §103

Applicant also requests review of the Examiner's rejection of claims 4-6 and 17-18 under 35 U.S.C. §103(a) as being unpatentable over Lin.

Applicant submits that claims 4-6 and 17-18 are allowable for at least the reasons set forth above and as discussed on page 11 of Applicant's response mailed August 9, 2005. Therefore, Applicant requests that the rejections be withdrawn.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Brian D. Kaul, Reg. No. 41,885
Suite 1400 - International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222 Fax: (612) 334-3312

BDK/djb